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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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ROBERT E BUSHNELL  
ATTORNEY-AT-LAW  
1322 K STREET NW  
SUITE 300  
WASHINGTON DC 20005-1202

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EXAMINER

BLACKBURN

ART UNIT	PAPER NUMBER
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2774

DATE MAILED: 06/14/98

8

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/840,892

Applicant(s)

Byoung-Han Kim

Examiner

Anthony Blackman

Group Art Unit

2774

☒ Responsive to communication(s) filed on Apr 17, 1997.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-10 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 1-4 and 6-10 is/are allowed.

☒ Claim(s) 5 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Apr 17, 1997 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Allowable Subject Matter***

1. Claims 1-2 are allowed.
2. Claims 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson(U.S. Patent No. 5,570,112) in view of Feierbach(U.S. Patent No.5,731,80).
5. Consider claim 3. Robinson discloses a computer mouse((Figures 1-3), further discloses the following features; a surface area(Figure 1(11), recessed area enclosing a gel or rubber or foam like pliable material(Figure 1(5)), however, does not teach these features as well as Feierbach. Feierbach discloses pliable body (Figure 1(22))has a skin enclosing a pliable material(referring to 'a housing having an upper surface, the upper surface including a primary

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recessed cavity', column 2; lines 24-30), 'a housing membrane covering the primary recessed cavity and forming a primary chamber', column 2; lines 24-30, 37-38), pliable material may be adapted for a comfortable fit('a quantity of gel...use of the computer mouse', column 2; lines 37-42), the pliable body allows the mouse to be shaped in a customizable reconfiguration('said gel...custom fit shape...to said initial shape', column 2; lines 37-42). It would have been obvious for one skilled in the art at the time of the invention to combine the pliable housing features of Feierbach with the computer mouse of Robinson because Robinson's modified computer mouse would have a more pliable structure conforming to the user's hand, additionally, the modified device would have the increased capability to conform to the user's's hand using Feierbach's bonding agent embodiment for a more permanent and hardened configuration(column 2; lines 43-60).

6. Consider claim 4. As to claim 3, Feierbach discloses first base assembly button and second base assembly button, (refers to 'wherein the upper surface includes at least one button'(Figure 3(26a, 26b), column 3; lines 4-7), however, does not adhere to the means for a secondary recessed cavity. Robinson discloses the means for a secondary recessed cavity (Figure 1 (6) column 1; lines 28-40). It would have been obvious for one skilled in the art at the time of the invention to combine the pliable housing features of Feierbach with the computer mouse of Robinson because Robinson's modified computer mouse would have a more pliable structure conforming to the user's hand, additionally, the modified device would have the increased

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capability to conform to the user's's hand using Feierbach's bonding agent embodiment for a more permanent and hardened configuration(column 2; lines 43-60).

7. Consider claim 5. As to claim 4, Feierbach discloses the means for a button membrane covering the secondary recessed cavity and forming a second chamber(Figure 1(22), referring to the pliable membrane surface and Figure 3(26a and 26b)referring to the button(s) forming a secondary recessed cavity in pliable mouse body). It would have been obvious for one skilled in the art at the time of the invention to combine the pliable housing features of Feierbach with the computer mouse of Robinson because Robinson's modified computer mouse would have a more pliable structure conforming to the user's hand, additionally, the modified device would have the increased capability to conform to the user's's hand using Feierbach's bonding agent embodiment for a more permanent and hardened configuration(column 2; lines 43-60).

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kurani(U.S. Patent No. 5,820,968) disclose a shape retaining mousepad with resilient material. Alex(U.S. Patent No. 5,765,795) discloses a deformable computer mouse pad.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Blackman whose telephone number is (703) 305-0833. The examiner can normally be reached on Monday through Thursday from 8 a.m. to 4 p.m. EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe, can be reached on (703) 305-4709.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

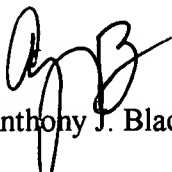
(703) 308-6606, (for formal communications intended for entry)

**Or:**

(703) 305-9731 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
Anthony J. Blackman  
June 5, 1999

  
MARK R. POWELL  
SUPERVISORY PATENT EXAMINER  
GROUP 2700